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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/796,383

03/09/2004

Lawrence J. Friedman

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08/10/2005

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EXAMINER

LEE, DIANE I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/796,383	FRIEDMAN, LAWRENCE J.	
	Examiner	Art Unit	
	D. I. Lee	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/2005, 3/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-23 are presented for examination.

Information Disclosure Statement

2. Although the first filed information disclosure statement (IDS) submitted on 3/9/2004 has been considered by the examiner, all the references listed on the IDS filed 3/25/2005 that are duplicate from the IDS (file date: 3/9/2004), except Danvenport, et al. [US 6,626,356], have been crossed out by the Examiner.

Claim Rejections - 35 USC § 112

3. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, line 1 read, "A method for a Host Based Smart (HBS) card". It is unclear whether the Applicant is claiming the purpose of the HBS card or intended use of the HBS card. Appropriate correction and clarification are required.

Re claim 3, lines 1-5 read, "wherein the informational element is a graphic representation of an individual, a graphic representation of a fingerprint, a graphic representation of an individual's iris, a representation of an individual's DNA, an identification number, a retinal scan". It appears that Applicant is claiming the informational element that is a graphic representation of an individual, a graphic representation of a fingerprint, a graphic representation of an individual's iris, a representation of an individual's DNA, an identification number, a retinal scan, all inclusively. However, the specification disclosed that the informational element selectively includes from a graphic representation of an individual, a

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graphic representation of a fingerprint, a graphic representation of an individual's iris, a representation of an individual's DNA, an identification number, a retinal scan inclusively or selectively. Thus, in light of the specification, the above limitations have been translated as -- the informational element includes any one of a graphic representation of an individual, a graphic representation of a fingerprint, a graphic representation of an individual's iris, a representation of an individual's DNA, an identification number, a retinal scan--. Appropriate correction and clarification are required.

Re claim 6, lines 1-5 read, "wherein the government issued card is a passport, national identification card, military card, social security card, federal officer identification card, federal employee card, federal official card, an approved non-driver identification card, welfare card, state officer identification card, state employee card, state official card, municipal officer identification card, municipal employee card, and state official card". It appears that Applicant is claiming the government issued card that is a passport, national identification card, military card, social security card, federal officer identification card, federal employee card, federal official card, an approved non-driver identification card, welfare card, state officer identification card, state employee card, state official card, municipal officer identification card, municipal employee card, and state official card, all inclusively. However, the specification disclosed that the government issued card is selectively include from a passport, national identification card, military card, social security card, federal officer identification card, federal employee card, federal official card, an approved non-driver identification card, welfare card, state officer identification card, state employee card, state official card, municipal officer identification card, municipal employee card, and state official card. Thus, in light of the specification, the above limitations have been translated as --the government issued card includes any one of a passport, national identification card, military card, social security card, federal officer

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identification card, federal employee card, federal official card, an approved non-driver identification card, welfare card, state officer identification card, state employee card, state official card, municipal officer identification card, municipal employee card, and state official card--. Appropriate correction and clarification are required.

Re claim 16, line 1 read, "A method for system maintenance of a Host Based Smart (HBS) card". It is unclear whether the Applicant is claiming the purpose of system maintenance of the HBS card or intended use of system maintenance of the HBS card. Appropriate correction and clarification are required.

Re claim 17: see the discussion regarding claim 3 above.

Therefore, claims 1, 3, 6, 16-17, and claims depend therefrom (i.e., claims 2, 4-5, 7-15, and 18-23) are vague and indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1-11 and 13-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Houvener [US 6,070,141, cited by the applicant].

Re claims 1-2, 5-7, 11, 13-16, and 20: Houvener discloses method of managing information elements and transactional accounts for a plurality of individuals initially registered (see col. 3, lines 15-62; col. 4, lines 58-64; and col. 5, lines 28+), populating a database with at least one informational element (a first identification unit) from an issued card (see col. 3, lines 15-20 and col. 9, lines 29-39); wherein the information element is from a government issued

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card, such as drivers' licenses, social security cards, military identification cards, birth certificates and the like (see col. 6, lines 6, lines 59+); ascribing at least one unique modifier (an identification quality score) to the informational element (see col. 3, lines 19-21); ascribing at least one transactional account to the unique modifier and linking the unique modifier to the information element (see col. 3, lines 21-62); obtaining at least one informational element (a second identification unit) from an issued card (see col. 3, lines 26-30; col. 4, lines 58-64; col. 5, lines 28+), and retrieving the informational elements from an External authorizing host, e.g., the existing credit authorization agencies sites (see col. 7, lines 45+).

Re claims 3 and 17: wherein the informational element is an identifier used to recognize or establish as being a particular individual and to verify the identity of the individual (see col. 3, lines 15-62; col. 4, lines 58-64; and col. 5, lines 6+). Wherein the informational element includes an identification number (a first identification unit from an issued card, such as a standard credit card account information, driver's license number, or a social security number, or the like to the individual (see col. 3, lines 15-20 and col. 9, lines 29-39).

Re claims 4 and 18: wherein a transactional account is an accommodation or service extended by an institution to a customer or client permitting the use of the accommodation or service towards goods or services (i.e., the point of sales, see col. 5, lines 28+).

Re claims 8-9: conducting a negative and a positive authorization search (see col. 3, lines 39+ and col. 8, lines 34+);

Re claims 10, 19 and 21-23: updating the informational elements with informational elements retrieved from the External Authorizing Host for each transaction, transactional accounts with each use of the transactional accounts, and retrieving and updating transactional account information from the External Authorizing Host (see col. 12, lines 31+).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Houvener. The teachings of Houvener have been discussed above.

Houvener does not explicitly point out that the unique modifier is alpha, numeric, alpha-numeric, and symbolic characters. However, Houvener teaches that the unique modifier (the identification quality score), which score identities and account numbers in terms of probability that are susceptible to identity-base fraud (see col. 6, lines 52+), at a level having a predetermined threshold which may be adjusted to upgrade or to degrade (see col. 7, lines 11+; col. 8, lines 64+; and col. 12, lines 21+). Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognize that such indication of the unique modifier could be accomplished in any form of alpha, numeric, alpha-numeric, and symbolic characters. Accordingly, it would have been an obvious expedient.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yu [US 5,748,908] and Sawin [US 2002/0066783] discloses a method and a system for managing information elements and transactional accounts for transaction cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'D. I. Lee', written in a cursive style.

D. I. Lee
Primary Examiner
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